



UNITED STATES DEPARTMENT OF COMMERCE  
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
077047,614	05/08/87	ROCKLAGE S	145,0002

WILLIAM B. WALKER  
2021 THE ALAMEDA, SUITE 110  
SAN JOSE, CA 95126

EXAMINER	
ROTMAN, A	
ART UNIT	PAPER NUMBER
121	5

DATE MAILED: 05/05/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892.       | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948.       |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449             | 4. <input type="checkbox"/> Notice of informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474 | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-54 are pending in the application.  
Of the above, claims 1-8 AND 20-54 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 9-19 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.
8. ☐ Allowable subject matter having been indicated, formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. These drawings are ☐ acceptable;  
☐ not acceptable (see explanation).
10. ☐ The ☐ proposed drawing correction and/or the ☐ proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved. ☐ disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.
12. ☐ Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103.

Restriction is required to one of the following invention:

Group I: Certain compounds capable of forming chelating or coordination complexes according to claims 1-8, 20 and 21, namely N,N -bis-(pyridoxal-5-phosphate)-ethylenediamine-N,N'-diacetic acid and derivatives thereof, classified in Class 546; Subclass 261.

Group II. Chelated complexes according to claims 9-19 wherein the metal ion is selected from the group consisting of calcium (II), manganese (II), iron (III), chromium (III), copper (II), cobalt (II), nickel (II) praseodymium (III) neodymium (III), samarium, ytterbium (III), gadolinium (III), terbium (III), dysprosium (III), holmium (III) and erbium (III) classified in Class 546; subclasses 8 and 261.

Group III: Complexing compositions according to claims 32-43. Classified in Class 514; subclass 184.

Group IV: Methods of NMR imaging according to

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claims 44-54 classified in Class 128, subclass 653.

Claims 1-8 and 20-54 stand withdrawn from further consideration 37 CFR 1.142(b) as being drawn to non-elected inventions. Election was made with traverse by applicants attorney, Mr. William Walker on May 10, 1988 wherein the invention identified as Group II was provisionally elected for a complete examination on the merits.

Claims 9-19 are rejected under 35 USC 101 and 112 (first and second paragraphs). First, of all it is only speculative on the part of applicants to allude to a positive structure on pages 9 and 10 of the instant specification that the specific metal forms 2 separate six membered rings when there are 2 N-acetic acid moieties, 1 or 2 phosphonic acid moieties, 2-hydroxy moieties attached to said pyridine once the alleged chelate is formed.

Claims 9 and 14 are rejected under 35 U.S.C. 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Specifically, these claims are dependent upon claims drawn to a non-elected invention.

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INFORMAL DRAWINGS

The drawings submitted on May 8, 1987 are so informal, they cannot be corrected, for example

(a) lines blurred.

(b) Paper undersized, either 8½" by 14" are required.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Alan L. Rotman whose telephone number is (703) 557-3770.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 557-3920.

05/04/89;rbb

*Alan L. Rotman*  
Alan L. Rotman  
Examiner  
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